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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/149,721 09/08/98 MUMPER R 237/023

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HM12/0720

EXAMINER

OWENS JR, H

ART UNIT

PAPER NUMBER

1623

DATE MAILED:

07/20/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/149,721

Applicant(s)
Mumper et al.

Examiner
Howard Owens

Group Art Unit
1623



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-9 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-9 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-9 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit 1623

RESPONSE TO RESTRICTION/ELECTION

5 Claims 10-40 have been canceled as set forth in the amendment
filed by applicant on 4-6-1999.

References provided by applicant which are applicable to the
canceled claims have not been considered by the examiner.

10 References germane to claims 1-9 have been considered.

An action on the merits of claims 1-9 is contained herein below.

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DETAILED ACTION

This application currently names joint inventors. In
considering patentability of the claims under 35 U.S.C. 103(a),
20 the examiner presumes that the subject matter of the various
claims was commonly owned at the time any inventions covered
therein were made absent any evidence to the contrary. Applicant
is advised of the obligation under 37 CFR 1.56 to point out the
inventor and invention dates of each claim that was not commonly
25 owned at the time a later invention was made in order for the
examiner to consider the applicability of 35 U.S.C. 103(c) and
potential 35 U.S.C. 102(f) or (g) prior art under 35
U.S.C. 103(a).

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35

35 U.S.C. 112:

The specification shall conclude with one or more claims
particularly pointing out and distinctly claiming the subject
matter which the applicant regards as his invention.

Art Unit 1623

Claims 1-9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 2, it is unclear as to what applicant intends the formula to be when R6 = methyl and the methyl is not a terminal methyl group. For instance, in the formula $-O-CH_2-CH_2(OR_6)-CH_2(OR_7)R_6$ can not be methyl because of the bond limitation.

In claim 2, it is unclear as to whether the provisions set forth in lines 5-10, p. 84 are to be associated with n, m, or R6 individually or collectively. Moreover, in the instance that these provisions are not met for each n, m or R6 variable, it is unclear as to what the claimed compound or variables would represent given that no alternatives are set forth. Accordingly, dependent claims 3-9 are rejected as they fail to obviate the rejections set forth in the parent claim(s).

Art Unit 1623

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Chemical Abstracts, Vol. 64, 17696f, 18009a, 19745g; and Vol. 65, pp. 3944f, 7258g, 15476f, 15481b, 20203f.

Claims 1-5 are drawn to a compound comprising a glycosyl moiety having a nitrogen based substituent linked to a carbon atom within said glycosyl moiety, wherein said nitrogen-based substituent is selected from the group consisting of -NH₂, -N+(CH₃)₃, -(CH₂)_n-N(R₁₀)₃, -NH-C(NH₂)-NH₂; wherein substituents linked to other carbon atoms within said glycosyl moiety are independently selected from the group consisting of hydrogen, alkyl, -O-alkyl and various other carbonyl and amine based substituents.

The instant claims are anticipated by the CA references cited supra when: the nitrogen based substituent is -NH₂ and the other carbon atoms are independently selected from hydrogen, alkyl, -O-alkyl; R₁' and R₁ are independently selected from the group consisting of hydrogen, OH, alkyl; R₂ and R₂' are independently selected from the group consisting of -NH₂ and

Art Unit 1623

hydrogen; R3, R3', R4, R4', R5 and R5' are independently selected from the group consisting of hydrogen, OH, -NH2.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard Owens whose telephone number is (703) 306-4538 . The examiner can normally be reached on Mon.-Fri. from 8:30 a.m. to 5 p.m.

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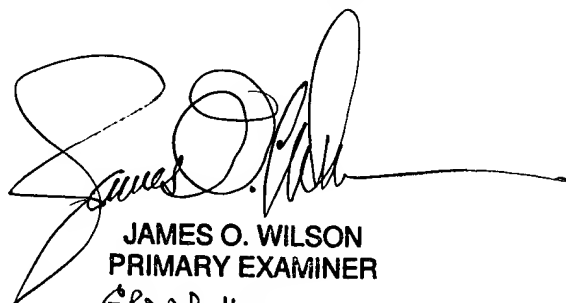
If attempts to reach the examiner by telephone are unsuccessful, the Primary Examiner signing this action, James O. Wilson can be reached on (703) 308-4624 . The fax phone number for this Group is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Howard Owens
Group 1623

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JAMES O. WILSON
PRIMARY EXAMINER
Group 1600